

The opinion in support of the decision being  
entered today is binding precedent of the Trial Procedures Section.

Paper 33

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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PAUL J. SHUSTACK

Junior Party,  
(Patent 6,014,488),

v.

DAVID M. SZUM, CHANDER P. CHAWLA, JAMES R. PETISCE  
JOHN T. VANDEBERG, GEORGE PASTERNAK,  
TIMOTHY E. BISHOP, PAUL E. SNOWWHITE,  
EDWARD P. ZAHORA, and STEPHEN C. LAPIN

Senior Party,  
(Application 09/757,533).

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Patent Interference No. 105,228

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Before: FLEMING, Chief Administrative Patent Judge, and  
McKELVEY, Senior Administrative Patent Judge, and MEDLEY, Administrative Patent Judge.<sup>1</sup>

MEDLEY, Administrative Patent Judge.

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<sup>1</sup>As part of Board efforts under the Government Paperwork Elimination Act, signatures on papers originating from the Board are being phased out in favor of a completely electronic record. Consequently, in this case papers originating at the Board will not have signatures. The signature requirements for the parties have not changed. See, e.g., 37 C.F.R. § 10.18.

### **Judgment - Request for Adverse - Bd. R. 127(b)**

On 2 June 2005, the board received from the party Szum a paper entitled “SZUM CONCESSION OF PRIORITY (37 C.F.R. 41.127)” (Paper 32). The content of paper 32 is as follows (emphasis added as underlined):

This is a Concession of Priority of Party Szum.

Party Szum concedes priority of the subject matter of the count in the subject interference and will accede to adverse judgment as a result thereof, pursuant to [Bd. R] 41.127(b).

Party Szum does not concede priority or, take any position herein, with regard to any disclosed or claimed subject matter which is set forth in the Szum pending and involved application, Serial No. 09/757,533, but which does not correspond to the count or, which would support a claim which would not, if entered, be deemed to correspond to the count.

The board treats a concession of priority as a request for adverse judgment. Bd. R. 127(b)(3). The estoppel effects of a judgment are provided for in Bd. R. 127(a) which states that:

A judgment disposes of all issues that were, or by motion could have properly been, raised and decided. A losing party who could have properly moved for relief on an issue, but did not so move, may not take action in the Office after the judgment that is inconsistent with that party's failure to move, except that a losing party shall not be estopped with respect to any contested subject matter for which that party was awarded a favorable judgment.

Szum's attempt to limit the effects of the requested adverse judgment, as set out in the underscored paragraph, does not prevent or avoid the effect of Bd. R. 127(a). The estoppel effects apply in full force, no matter how Szum has attempted to limit its concession of priority. Eli Lilly and Co. v. Cameron, 61 USPQ 1863 (Bd.Pat.App. & Int. 2001).

The underlined portion of Szum's concession of priority has been accorded no weight and will be accorded no weight in future prosecution by Szum before the USPTO. Paper 32 of the official record of the interference file has been modified, such that the limiting paragraph underlined above is stricken through. The decision to enter judgment against Szum is based solely upon Szum's request for a concession of priority, less the underlined portion reproduced above.

Should either party believe that Szum's request for adverse judgment has been "misapprehended," the party may file a request for rehearing under Bd. R. 127(d).

Upon consideration of the record it is

**ORDERED** that judgment on priority as to Count 1 (Paper 1 at 5) is awarded against senior party DAVID M. SZUM, CHANDER P. CHAWLA, JAMES R. PETISCE, JOHN T. VANDEBERG, GEORGE PASTERNAK, TIMOTHY E. BISHOP, PAUL E. SNOWWHITE, EDWARD P. ZAHORA, and STEPHEN C. LAPIN.

**FURTHER ORDERED** that senior party DAVID M. SZUM, CHANDER P. CHAWLA, JAMES R. PETISCE, JOHN T. VANDEBERG, GEORGE PASTERNAK, TIMOTHY E. BISHOP, PAUL E. SNOWWHITE, EDWARD P. ZAHORA, and STEPHEN C. LAPIN is not entitled to a patent containing claims 74–80 (corresponding to Count 1) of application 09/757,533.

**FURTHER ORDERED** that a copy of this paper shall be made of record in files of application 09/757,533 and U.S. Patent 6,014,488.

**FURTHER ORDERED** that if there is a settlement agreement, attention is directed to 35 U.S.C. § 135(c) and Bd.R. 205.

cc (via overnight delivery - copy of judgment and  
copy of paper 32 of the official record):

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